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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,031	01/16/2001	Richard E. Rowe	29757/P-265	4234

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EXAMINER
ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)	
	09/761,031	ROWE, RICHARD E.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication app ars on the cover sheet with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34, 39, 41, 46, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slomiany et al., U.S. Patent 6,159,098 (Dec. 12, 2000) in view of Gilmore et al., U.S. Patent 6,347,996 B1 (Feb. 19, 2002).

The prior holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 3-5, 11-13, 19-21, 27-29, 35-37 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Slomiany* in view of *Gilmore*, as applied to claim 1 above, in further view of Walker et al., U.S. Patent 6,110,041 (Aug. 29, 2000)

In regards to claims 3, 5, 11, 13, 19, 21, 27, 29, 35, 37, 42 and 44: The gaming system described by the combination of *Slomiany* and *Gilmore* discloses several input devices including an electronic reader capable of reading an item having data stored thereon. *See Slomiany, fig. 1(a).* The game controller in *Slomiany* is programmed to cause the value dispensing mechanisms to dispense value after the bonus payout has been determined based on the data received from ~~the read from~~ the electronic reader or tracking system. *See col. 9:14-21.* In particular, the bonus payout dispensed to the player is based upon the number of credits wagered in the main game as entered though the input devices. *See Slomiany, fig. 9, 10; col. 10:10-63.* Thus the combination of *Slomiany* and *Gilmore* describes all the features of the claims except dispensing the bonus payout based on user preference information stored on the item. Regardless, this feature would have been obvious to an artisan in view of *Walker.*

Walker discloses a gaming system in which players' gaming machine preferences are associated with a tracking card. *See fig. 9-11(b); col. 2:13-53.* Based on the players' preferences the slot machine

can be configured according to operative according to the players' preferences of, for example, game type, language or form of payout. *See col. 1:55-65.* As a result, players' interest in the gaming device can be increased while reducing their frustrations. *See id.*

In view of *Walker*, it would have been obvious to an artisan at the time of the invention to modify the gaming system described by the combination of *Slomiany* and *Gilmore*, in which a ~~player~~ games posses an electronic reader for accepting player data from an "item", to add the feature of dispensing the bonus payout based on user preference information stored on the item. As suggested by *Walker*, configuring a gaming system based on player preference increases player interest while reducing their frustration. *See id.* As a result, operator revenue would increase in accordance with increased player usage.

In regards to claims 4, 12, 20, 28, 36 and 43: *Walker* additionally teaches a player tracking system wherein the game controller is programmed to transmit data stored on a item to the player tracking system via an interface and to receive information related to the user associated with the item having data stored thereon from the player tracking system via the interface. *See id.*

Claims 6, 14, 22, 30, 38 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Slomiany* in view of *Gilmore*, as applied to claim 1 above, in further view of Burns et al., U.S. Patent 6,048,269 (Apr. 11, 2000) and Sunders et al., U.S. Patent 6,340,331 B1 (Jan. 22, 2002).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 8, 16, 24, 32, 40 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Slomiany* in view of *Gilmore*, as applied to claims 1 above, in further view Adams, U.S. Patent 6,113,098 (Sep. 5, 2000).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

Applicant's arguments, filed Feb. 7, 2003, with respect to the rejection of claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34, 39, 41, 46 48 and 49 have been fully considered but are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In particular, the applicant contends the claims distinguish over the prior art because neither *Slomiany* nor *Gilmore* teach an award being dispensed from the bonus game is actually dispensed from the gaming machine to the user at any time other than the same time that any award from a main game is dispensed to the user. Instead, the claims merely require that a value-dispensing mechanism dispense a bonus payout after the bonus payout to the user. *Slomiany* meets this limitation because, upon completion of the bonus game, the gaming system dispenses the bonus credits earned in the bonus game by a value-dispensing mechanism to a credit meter. Consequently, the rejection is maintained because when *Slomiany* and *Gilmore* are taken as a whole by an artisan at a time prior to the invention, the combination suggests the claimed feature of a value-dispensing mechanism dispense a bonus payout after the bonus payout to the user.

Applicant's arguments with respect to claims 3-5, 11-13, 19-21, 27-29, 35-37 and 42-44 have been considered but are moot in view of the new grounds of rejection.

Prior Art Not Relied On.

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

a. Georgilas, U.S. Patent 5,067,712 discloses a gaming device having a primary and secondary game segments in which physical tokens are dispensed from the game machine at the end of each segment.

b. Walker et at., U.S. Patent 6,537,151 B1 (Mar. 25, 2003) teaches that it known in the art to dispense awards as either physical tokens or intangible credits. Furthermore, it discloses setting the type based on player preference contained on a player tracking card.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

Steven Ashburn
April 9, 2003

MARK SAGER
PRIMARY EXAMINER